UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,265	07/06/2001	Kazuhiro Yabuta	JP920000193US1	7588

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EXAMINER
FADOK, MARK A

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
08/24/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

RSWIPLAW@us.ibm.com

	Application No.	Applicant(s)
	09/900,265	YABUTA ET AL.
Office Action Summary	Examiner	Art Unit	
	MARK FADOK	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 May 2009_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _6-8, 16 and 17_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☐ Claim(s) _____ is/are rejected.
7)☒ Claim(s) _6-8, 16 and 17_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

The examiner is in receipt of applicant's response to office action mailed 4/7/2009, which was received 5/27/2009. Acknowledgement is made to the amendment to claims 6 and 16 leaving claims 6-9, 16 and 17 as pending in the instant application. Applicant's amendment and remarks were persuasive in overcoming the USC 101 and 103 rejections of the previous office action however after further search and consideration the following new ground of rejection follows:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-9, 16 and 17 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim first positively receives a connection request from a cellular phone includes an identifier. The specification does not provide for a situation where there is an identifier provided from the gateway to the ecommerce server then the ecommerce system somehow having the identifier removed so that the final step of in response to determining that the connection request does not include the identifier, "executing session control <u>by the electronic commerce server </u>for the device

using history information that is communicated between the system and the device" or

in the case of claim 16 the connection request does not have the identifier i.e. "in

response to determining that the connection request does not include the identifier." In

this case the identifier cannot be determined but somehow it is stored in the very next

step.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 6-9,16 and 17 are directed to non-statutory subject matter. Based on

Supreme Court precedence see Diamond v Diehr 450 US 175,184 (1981); Parker v.

Flook, 437 US 584,588,n. 9 (1978); Gottschalk v Benson, 409 US 63, 70 (1972);

Cochtane v Deener, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to

another statutory class (such as an apparatus) or transform underlying subject mater

(such as an article or materials) to a different state or thing. Since neither of these

requirements is met by the claim the claim is rejected as being directed to non-statutory

subject matter. In this case although there is a particular machine in the form of the

server the other portion of the claim which is critical to the novel functionality of the

claim as argued by the applicant that includes the gateway does not provide for the use

of a particular machine.

Double Patenting

Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 9. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of

the allowed claim. See MPEP § 706.03(k). In this case the contents of claim 9 have

been added to claim 6 and are recited now in a redundant manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-9,16 and 17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smethers (US PG PUB 20030055870) in view of FOX (US

6,421,781_further in view of Applicant's Admitted Prior Art (APA).

In regards to claim 6, Smethers discloses receiving <u>at a gateway, </u>a connection

request from a <u>cellular phone;</u>

<u>responsive to receiving the connection request from the cellular phone, adding</u>

<u>by the gateway an identifier to the connection request, wherein the identifier</u>

<u>corresponds to an identification code of the cellular phone and wherein the identifier</u>

<u>identifies that the connection request is from the cellular phone;</u>

<u>responsive to adding the identifier to the connection request, forwarding the</u>

<u>connection request to an electronic commerce server (FIG 8);</u>

determining <u>by the electronic commerce </u>server whether the connection request

includes the identifier,

Smethers teaches a server in contact with a wireless device and a PC (FIG 2),

but does not specifically mention that when the identifier is not present from a requester

then the sever used history information to communicate to a device.

As Observed by the Board in Appeal 2007-1930:

"Fox discloses a server, such as device 202, which provides information accessible to

other computing devices on the Internet 104 (Fox, col.5, lines 27-29). Fox discloses that

other such computing devices connected to the Internet can be desktop personal

computers (Fox, col. 3, line 55). It would appear that the server 202 provides

information accessible to both computers and mobile devices, and thus receives

connection requests from both types of devices. ((It would have been obvious to a

person having ordinary skill in the art a the time of the invention to include using a different mechanism to effect session control when a request was not from a proxy that has sent a request with a device identifier, because this will allow a single server to process multiple request thus decreasing the cost of providing a separate server) not part of the BPAI response).

APA describes using history information, i.e., a cookie, to effect session control where the connection request involved is not from a mobile device (instead, a computer) as required by claims 6 and 16. (Specification 3:5-9)

As to the limitation in claims 6 and 16 of "determining whether the connection request includes an identifier, wherein the identifier corresponds to an identification code of a cellular phone and wherein the identifier identifies that the connection request is from a cellular phone," Fox discloses:

Referring to the table in FIG. 3, a subscriber ID list 302 maintains a list of subscriber IDs of the mobile devices... " (Fox col. 6, ii. 29-30) The URLs representing the information subscribed to by the user are grouped and maintained in URL table 306. It can be appreciated that subscriber ID list 302 generally maintains a plurality Of subscriber IDs, each corresponding to one mobile device... (Fox, col. 6, 11. 43-49).

Fox would appear to disclose determining an identifier (ID) associated with a mobile device as required by claims 6 and 16 because, in Fox, the IDs in list 302 are grouped together as mobile devices, and any connection request using an ID from this group (302) would be known or identified by the system as being associated with a mobile device based on the group classification. "

Accordingly, it would have been obvious to one of ordinary skill in the art to have

provided the combination of Fox and APA. All of the recited steps are shown by the

combination of Fox and APA and there is no evidence of unpredictable results. Under

these circumstances, " [t]he combination of familiar elements according to known

methods is likely to be obvious when it does no more than yield predictable results."

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007)."

        Fox teaches determining if an identifier is present in the request and if

there is no identifier, determining if there is some other string from the notification

request that can serve as the identifier (col 10, lines 40-47). As stated above, APA

describes using history information, i.e., a cookie, to effect session control where the

connection request involved is not from a mobile device (instead, a computer) as

required by claims 6 and 16. (Specification 3:5-9). It would have been obvious to a

person having ordinary skill in the art to use a cookie provided with the notification to

effect session control if an identifier was not provided indicating that the call is from a

cellular phone, because the use of cookies to establish identity of a user was an

efficient manner of authentication commonly used by programmers and would have

therefore been obvious to try as an option when searching for some means of

identification in the request.

        In regards to claim 7, the combination of Smethers, Fox and APA executing the

connection request using the appropriate session control;

receiving a result from the execution of the connection request; and returning the

result to the device (Smethers, para 42 and 43).

In regards to claim 8, the combination of Smethers, Fox and APA wherein the

network comprises a first network for communicating with the device and a second

network for communicating with the cellular phone and the method further comprises a

step of sending the connection request from the cellular phone through the second

network (see response to claim 1).

In regards to claim 9, the combination of Smethers, Fox and APA teach the step

of adding the identification code corresponding to the identifier to said connection

request sent from the cellular phone (see response to claim 1).

In regards to claim 16, Smethers discloses a commodity purchasing method

through a network, comprising the steps of:

receiving <u>at a gateway,</u> a connection request from a <u>cellular phone;</u>

<u>responsive to receiving the connection request from the cellular phone, adding</u>

<u>by the gateway an identifier to the connection request, wherein the identifier</u>

<u>corresponds to an identification code of the cellular phone and wherein the identifier</u>

<u>identifies that the connection request is from the cellular phone;</u>

<u>responsive to adding the identifier to the connection request, forwarding the</u>

<u>connection request to an electronic commerce server (FIG 8);</u>

determining <u>by the electronic commerce</u> server whether the connection request

includes the identifier,

Smethers teaches a server in contact with a wireless device and a PC (FIG 2),

but does not specifically mention that when the identifier is not present from a requester

then the sever used history information to communicate to a device.

As Observed by the Board in Appeal 2007-1930:

"Fox discloses a server, such as device 202, which provides information accessible to

other computing devices on the Internet 104 (Fox, col.5, lines 27-29). Fox discloses that

other such computing devices connected to the Internet can be desktop personal

computers (Fox, col. 3, line 55). It would appear that the server 202 provides

information accessible to both computers and mobile devices, and thus receives

connection requests from both types of devices. ((It would have been obvious to a

person having ordinary skill in the art a the time of the invention to include using a

different mechanism to effect session control when a request was not from a proxy that

has sent a request with a device identifier, because this will allow a single server to

process multiple request thus decreasing the cost of providing a separate server) not

part of the BPAI response).

APA describes using history information, i.e., a cookie, to effect session control

where the connection request involved is not from a mobile device (instead, a computer)

as required by claims 6 and 16. (Specification 3:5-9)

As to the limitation in claims 6 and 16 of "determining whether the connection request includes an identifier, wherein the identifier corresponds to an identification code of a cellular phone and wherein the identifier identifies that the connection request is from a cellular phone," Fox discloses:

Referring to the table in FIG. 3, a subscriber ID list 302 maintains a list of subscriber IDs of the mobile devices... " (Fox col. 6, ii. 29-30) The URLs representing the information subscribed to by the user are grouped and maintained in URL table 306. It can be appreciated that subscriber ID list 302 generally maintains a plurality Of subscriber IDs, each corresponding to one mobile device... (Fox, col. 6, 11. 43-49).

Fox would appear to disclose determining an identifier (ID) associated with a mobile device as required by claims 6 and 16 because, in Fox, the IDs in list 302 are grouped together as mobile devices, and any connection request using an ID from this group (302) would be known or identified by the system as being associated with a mobile device based on the group classification. "
Accordingly, it would have been obvious to one of ordinary skill in the art to have provided the combination of Fox and APA. All of the recited steps are shown by the combination of Fox and APA and there is no evidence of unpredictable results. Under these circumstances, " [t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."
KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007)."

Fox teaches determining if an identifier is present in the request and if there is no identifier, determining if there is some other string from the notification

request that can serve as the identifier (col 10, lines 40-47). As stated above, APA describes using history information, i.e., a cookie, to effect session control where the connection request involved is not from a mobile device (instead, a computer) as required by claims 6 and 16. (Specification 3:5-9). It would have been obvious to a person having ordinary skill in the art to use a cookie provided with the notification to effect session control if an identifier was not provided indicating that the call is from a cellular phone, because the use of cookies to establish identity of a user was an efficient manner of authentication commonly used by programmers and would have therefore been obvious to try as an option when searching for some means of identification in the request.

In regards to claim 17, the combination of Smethers, Fox and APA executing the connection request using the session control; receiving a result from the execution of the connection request; and returning the result to the device (Smethers, col 42 and 43).

Response to Arguments

Applicant's arguments with respect to claims 6-9,16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

<div align="center">

Commissioner for Patents

P.O. Box 1450

</div>

Alexandria, Va. 22313-1450
or faxed to:

> **571-273-8300**   [Official communications; including
>
> After Final communications labeled
>
> "Box AF"]
>
> For general questions the receptionist can be reached at

571.272.3600

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/
Mark Fadok
Primary Examiner, Art Unit 3625